

### REMARKS

Claims 1, 5, 14, and 16-18 stand rejected under 35 U.S.C. 102(e) as allegedly anticipated by Harmer (U.S. Patent No. 4,682,889). Claims 6-13 and 19-20 stand rejected as allegedly obvious over Ivanisov et al. (WO 01/18741) in view of Harmer.

Applicants' invention, in one configuration, is directed to an imaging device comprising an optical plate made of an optically transparent material forming a surface for receiving a finger and having an index of refraction less than 1.49. Applicants' invention, in another configuration, is directed to an imaging device in which the optical plate has an index of refraction less than the index refraction of the finger.

The particular indices of refraction of the optical plate of Applicants' inventions are selected to make the imaging device thinner so that it may fit, for example, in portable or compact electronic apparatuses. (*See, e.g.*, Applicants' specification at pg. 4, lines 9-12.)

Applicants' invention, in another configuration, is directed to a method of forming an optical plate. The method comprises molding a silicone material into a base, forming a reflective device and attaching the reflective device to the base to form a reflective interface between the base and the reflective device. In another configuration, Applicants' invention is directed to a method of forming an optical plate comprising: forming a transparent hollow device having sides, applying a coating to an inner surface of one of the sides to form a reflective surface on that side, dispensing silicone material into the hollow device, and hardening the silicone material to form the optical plate.

Harmer and Ivanisov simply do not disclose, teach or suggest Applicants' claimed inventions.

Initially, it is noted that Harmer issued on July 28, 1987. This is more than a year prior to the filing of Applicants' application. As such, the statutory ground for rejection based on Harmer should be 35 U.S.C. 102(b), and not 35 U.S.C. 102(e).

Nevertheless, according to the examiner, Harmer teaches “a fingerprint detecting device comprising an optical plate (12) made of material with a refraction index of 1.412, a light source (30) and a sensor positioned to receive light collected from the finger.”

Harmer does not disclose a fingerprint detecting device. Also, there is absolutely no reference in Harmer to “an optical plate (12), “a refraction index of 1.412”, a light source (30)”, or “a sensor positioned to receive light collected from [a] finger.”

Rather, Harmer discloses a refractometer including a light source DEL and a prism P immersed in a liquid L. Harmer’s refractometer is used to measure the refractive index of the liquid. The prism has a semi-cylindrical face 1 that receives incident light rays from a electroluminescent diode (DEL). The diode and the semi-cylindrical face 1 are immersed in the liquid. The prism has an exit face 2 for refracted rays of the incident beam, which forms an angle  $\theta$  with a convergence plane 3 of the refracted rays, parallel to a diametrical plane of the semi-cylindrical face 1 that receives the incident rays, perpendicular to the general direction of the refracted rays  $rr$  through the prism P. (*See, e.g.*, Col. 3, lines 9-20). This particular configuration of the refractometer permits the measurement of the refractive index of the liquid substantially independent of its temperature. (Col. 2, lines 15-18). The prism P may be made of various materials having an index of refraction between 1.4612 (for ICI) and 1.586 (for Poly Carbonate). (*See, e.g.*, Table 1).

Harmer discloses a refractometer for measuring the index of refraction of a liquid. It does not disclose a fingerprint imaging device. Harmer also does not disclose an optical plate for receiving a finger, a light source to illuminate the finger receiving surface, and an imaging system positioned to receive light collected from the finger receiving surface to form an image of a fingerprint pattern of the finger. Thus, Harmer cannot possibly anticipate or render obvious Applicants’ claimed invention.

Applicants believe that claims 19-20 are directed to patentable subject matter. These claims were rejected as unpatentable over Ivanisov et al. in view of Harmer. However, there is absolutely no disclosure in either reference of the methods set forth in the claims. Indeed, there is no disclosure in either reference of any sort of method for making an optical plate.

Additionally, the examiner's comment that she "will considering (sic) examining the claims after an election in reply to a restriction" is not understood. The examiner, as discussed, has apparently examined claims 19-20, since they were rejected as obvious. Moreover, no restriction requirement has ever been issued between the subject matter of claims 1-18 and 19-20.

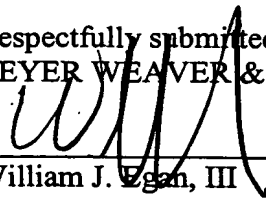
Further, Applicants believe that the final rejection was premature. Applicants, in response to the last Office Action, did not amend the claims. The examiner, however, has now introduced a new ground of rejection by relying on Harmer and Ivanisov et al. As stated in the MPEP, a second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection that was not necessitated by Applicants' amendment of the claims. (*See, e.g.* MPEP §706.07(a)). Therefore, Applicants request that the examiner reconsider her decision to make this Office Action final and then withdraw it as premature. (*See, e.g.* MPEP §§706.07(c) and (d)).

In view of the foregoing, it is submitted that all the claims are in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the examiner is requested to call Applicants' undersigned attorney at (510) 495-3206.

Please apply any other charges or credits to Deposit Account No. 500388.

Respectfully submitted,  
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